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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/749,164	12/30/2003	Zbigniew Tokarski	3216.36US02	7875

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EXAMINER

RODEE, CHRISTOPHER D

ART UNIT PAPER NUMBER

1756

DATE MAILED: 10/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/749,164

Applicant(s)

TOKARSKI ET AL.

Examiner

Christopher RoDee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 and 23-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-10, 12-14 and 23-26 is/are rejected.
- 7) ☒ Claim(s) 4 and 11 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>4/23/04 8/3/04</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicant's election without traverse of claims 1-14 and 23-26 in the reply filed on 10 October 2005 is acknowledged. The non-elected claims have been canceled.

Claim Objections

Claims 2, 9, and 24 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Each of these claims permits R₁₀, R₁₁, and R₁₂ to be a part of a cyclic group but the base claims provides no such definition for the corresponding structures. As such, the dependent claims are of broader scope than the base claims.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-3, 5-10, 12-14 and 23-25 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for charge transport compounds and the devices, articles, and processes containing these compounds where the structure of R₁, R₂, R₃, R₄, R₁₀, R₁₁, and R₁₂ is a defined group, does not reasonably provide enablement for these

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groups defined as a part of a cyclic group. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims. The instant claims permit each of R_1 , R_2 , R_3 , R_4 , R_{10} , R_{11} , and R_{12} to be defined as a part of a cyclic group. There is no disclosure in the specification as filed of how to make a part of a cyclic group. The specification discloses either ring structures (e.g., aryl groups) or non-ring structures (e.g., alkyl groups). None of the disclosure shows how the artisan can produce the compounds of the instant claims having either a part of a cyclic group.

The artisan would have to resort to undue experimentation to produce compounds having the "part of a cyclic group" as claimed.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-3, 5-10, 12-14 and 23-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The instant claims are indefinite in the definition of R_1 , R_2 , R_3 , and R_4 as "a part of a cyclic group" in the independent claims and R_{10} , R_{11} , and R_{12} for dependent claims 2, 9, and 24. If the R group is a part of a cyclic group it is not cyclic (i.e., a ring) itself. Such an incomplete structure does not particularly point out and distinctly claim the invention because it is unclear how such a partial structure defines, with the other components, a charge transport compound. Clarification is requested.

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Claims 2, 9, and 24 are also indefinite because it is unclear if Y' is limited to the recited atoms or group noting the "may be" language. It is unclear if other atoms or groups are permitted than those recited.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 23-26 are rejected under 35 U.S.C. 102(e) as being anticipated by Tokarski *et al.* in US Patent Application Publication 2004/0170910.

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Tokarski discloses 4-diethylamino-2-(1,2-epoxypropoxy)benzaldehyde N,N-diphenylhydrazone in ¶¶ [0081]-[0082]. This compound meets the requirements of the claimed compound where R₁ and R₂ ethyl, R₃ and R₄ are phenyl, X is phenyl, and Y is CH₂O. This

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compound is used to produce other charge transport compounds according to the document's claims.

The Examiner notes that the instant application has the same filing date as Tokarski and that each application claims domestic priority under § 119(e). In order for the instant application to be granted its claim to domestic priority it must describe and enable the claimed invention within the meaning of § 112, first paragraph (see MPEP 201.11). A review of the priority document shows that it does not describe the subject matter of the instant claims because the priority document only discloses the claimed compounds where where R_1 , R_2 , R_3 , and R_4 are, independently, an alkyl group, an alkaryl group, or an aryl group, X is a trivalent aromatic radical, Y is O, S, or N- R_5 where R_5 is hydrogen, an alkyl group, an alkaryl group, or an aryl group, and Z is an epoxy group. Even a cursory review of the instant claims shows that they encompass a far larger group of compounds than is described by the priority document. Consequently, the above rejected claims are not entitled to the earlier filing date of the § 119(e) priority claim.

The pertinent portion of the Tokarski reference is described by its § 119(e) priority document at page 17 (see MPEP 706.02(f)(1) and 2136.03). The reference has an earlier effective date because of this priority claim and is available as prior art under § 102(e) noting this date and the difference in inventive entities.

Allowable Subject Matter

Claims 1-3, 5-10, and 12-14 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

Claims 4 and 11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher RoDee whose telephone number is 571-272-1388. The examiner can normally be reached on most weekdays from 6:00 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on 571-272-1385. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

cdr
18 October 2005


CHRISTOPHER RODEE
PRIMARY EXAMINER